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APR 27 2007

OFFICE OF PETITIONS

WYATT, TARRANT & COMBS, LLP
1715 AARON BRENNER DRIVE
SUITE 800
MEMPHIS TN 38120-4367

In re Application of	:	
Herbage et al.	:	
Application No.: 10/763789	:	DECISION ON
Filing or 371(c) Date: 01/23/2004	:	PETITION
Attorney Docket Number: A310429.2US	:	

This is a decision in response to the Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office action, filed January 31, 2007. The petition is properly treated under 37 CFR 1.181. The delay in treating this petition is regretted.

This Petition is hereby **dismissed**.

Any further petition must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to timely reply to the Office communication, mailed June 7, 2006. The Office communication set a one (1) month period for reply. Extensions of time under 37 CFR 1.136(a) were available. No complete and proper reply having been received, the application became abandoned on July 8, 2006. A Notice of Abandonment was mailed January 18, 2007.

Petition under 37 CFR 1.181

Applicant files the instant petition and asserts non-receipt of the Office communication. Applicant states that all patent applications are routed through a central docketing clerk in the Memphis, Tennessee Office. The clerk also conducted a search of the application's file and docket entries and found no record of the June 7, 2006 Office communication.

Applicable Law, Rules and MPEP

The MPEP 711.03(c)A, Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action, provides

In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions). (Emphasis supplied)

MPEP 711.03(c)

Analysis

Office records reveal that there are Offices of Wyatt, Tarrant, & Combs, LLP, in Nashville and Memphis, Tennessee, and in Louisville, Kentucky. Office records reveal that Ms. Hills' Office is in Louisville, Kentucky. Ms. Hill affirms that the Office action was never received by Wyatt, Tarrant, & Combs, LLP, but Ms. Hill states that all patent applications are routed through a central docketing clerk in the Memphis, Tennessee Office. Petitioner is not at the correspondence address of record, and is thus not in a position to know whether the correspondence was received at the correspondence address of record. Nor has Petitioner filed a statement from the docket clerk – a person with firsthand knowledge of whether the Office communication was received at the correspondence address of record.

Moreover, it is apparent from the record that Applicant routes all patent related correspondence through the Memphis, Tennessee Office. Thereafter, the correspondence is forwarded to the appropriate Office of Wyatt, Tarrant, & Combs, LLP, in either Nashville or Memphis, Tennessee, or Louisville, Kentucky. As such, there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail.

Conclusion

Applicant has failed to overcome the presumption that the correspondence was received at the correspondence address of record. The petition is dismissed.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
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Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.


Derek L. Woods
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Office of Petitions